

REMARKS

This is in response to the Final Office Action mailed October 4, 2006 and the Notice of Non-Responsive Amendment dated March 16, 2007. Claims 10-16, and 25 have been withdrawn. Claims 17-24 and 26 remain pending.

Rejections Under 35 U.S.C. §103(a)

Biering et al. (WO98/25468/U.S. Pat. No. 6,540,960) in view of Lang et al. (U.S. Pat. No. 5,858,945) and Biering et al. (WO01/47565/U.S. Pat. No. 6,908,891) in view of Lang et al. (U.S. Pat. No. 5,858,945)

The Office Action has rejected claims 17-24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Biering et al. (US 6,540,960) in view of Lang et al. and Biering et al. (US 6,908,565) in view of Lang et al. Applicants respectfully traverse these rejections.

The Office Action of October 4, 2006 continues to interpret the pending claims as product-by-process claims. Applicants respectfully disagree with the characterization of the claims as product-by-process. The claimed embodiments of the invention are directed to improved peracid-generating powders and their use in making improved peracid solutions for disinfecting surfaces. Improved peracid-generating powders are needed for example to make sure that the powder dissolves completely in order to provide the desired disinfectant concentration faster and minimize the amount of undissolved powder that can leave a residue on a surface. See page 2 of the application as filed. When powders are used to make up peracid solutions, the dissolution rate of the powder is part of achieving the concentration of peracid in solution needed to disinfect a surface. If a user begins to use the solution prior to the complete dissolution of the powder, the peracid solution will not have the desired concentration of peracid and therefore may not be able to adequately disinfect the surface, leaving a hospital patient or

user at risk for exposure to microorganisms. The present claims are not directed to peracid compositions, but rather a method of use that involves dissolving the peracid-generating powders and then using the resulting improved peracid compositions for disinfecting surfaces. However, to the extent that the Examiner believes that the claims are product-by-process claims, the Examiner is encouraged to consider all of the elements of the claims. According to the MPEP § 2113, process steps should be considered when assessing patentability where the product can only be described by the process steps and where the steps would be expected to impart distinctive characteristics to the final product. This is the case here where the resulting peracid solution achieves a desired concentration faster and leaves less residue than peracid compositions made with prior art powders.

The Office Action uses Lang et al. to teach the specific EO/PO surfactant in claim 17 along with the peroxide, and acylating agent. Applicants respectfully disagree that Lang et al. teaches the specific nonionic surfactant of claim 17. The Office Action of May 25, 2006 points to column 8 line 15 to column 9 line 20 to teach the specific nonionic surfactant. While this text teaches EO/PO surfactants with 6 to 24 carbon atoms and 2 to 50 EO/PO units, it does not teach the preferred distribution of R groups as called out in claim 17. The specific surfactant of claim 17 is important for the improved dissolution rate and disinfectant properties as shown in Examples 1 and 2 of the present application. The generic EO/PO discussion in Lang et al. does not render the preferred distribution of the surfactant in claim 17 obvious because it does not teach or suggest the preferred distribution of claim 17 or give a reasonable likelihood of success that the surfactant of claim 17 would provide improved dissolution or disinfectant properties. The shortcomings of Lang et al. are not remedied by either Biering reference. Accordingly, it is respectfully requested that these rejections be withdrawn.

Obviousness-Type Double Patenting Rejection

The Office Action has rejected multiple claims under the judicially created doctrine of obviousness-type double patenting. Applicants believe that this rejection is moot in light of the above amendments and remarks. Accordingly, it is respectfully requested that this rejection be withdrawn.

Summary

It is respectfully submitted that each of the pending claims is in condition for allowance, and notification to that effect is kindly requested. The Examiner is invited to contact the Applicants' primary attorney-of-record, Anneliese S. Mayer, at (651) 795-5661, if it is believed that prosecution of this application may be assisted thereby.



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